

REMARKS/ARGUMENTS

This amendment is submitted in response to the final Office Action dated February 11, 2008 and the Examiner Interview Summary dated May 29, 2008. Reconsideration and allowance are requested.

Claims 6-10, 24-25, 27, and 33 remain in this application. Claims 1, 5, and 23 are canceled by this amendment. Claims 2-4, 11-22, 26, and 28-32 were previously canceled.

Examiner Interview

The Applicant would like to thank Examiner Shapiro for the courtesies extended during the telephonic interview conducted on May 22, 2008. During the interview, the Applicant indicated that although he did not believe the claims were obvious in light of the cited references, he would consider amending the claims in order to expedite prosecution. The Examiner and the Applicant then discussed possible amendments to the claims and support in the specification for those claims. At the end of the interview, the Examiner suggested that the Applicant submit an RCE with the proposed amendments to the claims and that these amendments would be further searched and considered.

Claim Rejection under 35 USC 103

In the Office Action, claims 1, 5-10, 23-25, 27, and 33 were rejected under 35 USC § 103(a) as being unpatentable over Berezin et al (US 5,539,752) in view of Stephan et al (US 6,388,001 B1), further in view of Nishimura et al (US 5,761,337), further in view of Kumagai (US 5,394,481), further in view of Jarvis et al (US 6,297,644 B1) and still further in view of Baker (US 5,226,118). Counsel for assignee respectfully traverses.

According to MPEP §2143, in order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the

claims limitations. Moreover, according to *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) and MPEP 2143.03, all the claim limitations must be taught or suggested by the prior art.

Counsel for assignee believes that the cited references fail to teach or suggest all of the claimed limitations. For example, the Office Action has not shown where the cited references disclose the step of displaying as recited in the independent claims. The step of displaying in the claims is directed to displaying an image of the detected defect candidate on a display screen together with its two different defect categories with each having different standards. The cited references do not disclose this limitation and therefore the claims are patentably distinct over the cited references.

Although counsel for assignee does not believe that claims 1, 5-10, 23-25, 27, and 33 are obvious under the cited references, in an effort to expedite prosecution claims 1, 5 and 23 have been canceled and claims 6-10, 24-25, 27, and 33 have been amended to be further distinguishable over the cited references.

Specifically, claims 6-10, 24-25, 27, and 33 have been amended so that the first category is based on a visual appearance of the defect candidate and the second category is based on the criticality of the defect candidate. Support for this amendment can be found throughout the originally filed application including page 22 of the originally filed specification. None of the cited references disclose such a feature. For example, Berezin is silent about displaying two different types of defect categories together with an actual image of the defect candidate. As described in the first paragraph of page 22 of the originally filed application, by displaying two different types of defect categories together with the actual image of the defect candidate, useful information is provided not only for determining the cause of the defects based on the defect appearance but also for predicting product yield. Since none of the cited references, either alone or in combination, disclose such a limitation, the references can not be combined to teach each and every element of the claimed invention.

Therefore, counsel for assignee believes that all of the pending claims are patentable over the cited references. Counsel for assignee respectfully requests that the claims be examined in light of these amendments and remarks.

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Reply to Final Office Action dated February 11, 2008

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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